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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,920	09/30/2003	Christopher P. Knapp	279.640US1	2079

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EXAMINER
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KAHELIN, MICHAEL WILLIAM

ART UNIT	PAPER NUMBER
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3762

MAIL DATE	DELIVERY MODE
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03/17/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/675,920	<b>Applicant(s)</b> KNAPP ET AL.	
	<b>Examiner</b> MICHAEL KAHRELIN	<b>Art Unit</b> 3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11, 14-26, 30-40, 44 and 45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 14-26, 30-40, 44 and 45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1-11, 14-26, 35-40, 44, and 45 have been considered but are moot in view of the new ground(s) of rejection, necessitated by amendment.
2. Applicant's arguments, see "Remarks," filed 7/3/2007, with respect to the rejection(s) of claim(s) 30-34 under 35 USC 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of new art.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 9-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear whether the apparatus further comprises a fourth layer, or the third layer of claim 9 is the same third layer of claim 1. The Examiner is interpreting the third layer of claim 9 as a fourth layer, consistent with the limitations of the system claim 25.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3, 5, 6, 9-11, 15, 16, 18, 21, 22, 25, 26, 35, 36, 39, 40, 44, and 45 rejected under 35 U.S.C. 102(b) as being anticipated by Bolz et al. (US 5,964,794, hereinafter "Bolz").

7. In regards to claims 1, 16, 30, and 35, Bolz discloses a system comprising a pulse generator, an electrical lead having an electrode (abstract), wherein the electrode is coated with three layers (Fig. 8) comprising a first layer of insulative material (innermost layer) and a second and third layers comprising a pharmacological agent (col. 9, lines 20-28).

8. In regards to claims 3, 6, 18, 22, and 36, the pharmacological agent is an anti-inflammatory (col. 9, lines 20-28).

9. In regards to claims 5 and 21, the first layer is a polymeric base coat (claim 2), and the second layer is a matrix of polymer and pharmacological agent (col. 9, lines 20-28).

10. In regards to claims 9, 25, 39, and 44 the electrode further comprises a porous polymeric fourth layer (Fig. 8; "porous" because the drug molecules from the lower layers can escape).

11. In regards to claims 11, 26, and 40, the fourth layer regulates release because the drug molecules from the lower layers must pass through the third layer.
12. In regards to claim 15, the first layer increases impedance (col. 9, line 24).

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 30, 32, and 33 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bolz. Bolz discloses the essential features of the claimed invention, including an outer layer in which the only agent present is a pharmaceutical agent (i.e., "including only a pharmaceutical agent"). Alternatively, Bolz does not disclose that the outer surface is purely a pharmaceutical

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agent. It is well known in the implantable device arts to coat implants with pharmaceutical agents before implantation to provide the predictable results of delivering an effective amount of drug to combat inflammation, infection, pain, or other potential complication with electrode placement. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bolz's invention by coating the apparatus with only a pharmaceutical agent before implantation to provide the predictable results of delivering an effective amount of drug to combat inflammation, infection, pain, or other potential complication with electrode placement.

16. Claims 2, 4, 7, 8, 14, 17, 19, 20, 23, 24, 31, 34, 37, 38, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolz. Bolz discloses the essential features of the claimed invention except for a helical tip electrode, an anti-inflammatory of the claimed types, a base coat of ethylene vinyl alcohol, a pharmaceutical agent including an anti-proliferative drug, or applying the coatings by spraying. It is well known in the implantable device arts to provide helical tip electrodes to provide the predictable results of solid lead fixation, an anti-inflammatory of the claimed types to provide the predictable results of avoiding inflammation with known substances, ethylene vinyl alcohol in implantable devices to provide the predictable results of an implantable polymer with known biocompatibility, a pharmaceutical agent including an anti-proliferative drug to provide the predictable results of avoiding the formation of scar tissue around the electrode, and applying the coatings by spraying to provide the predictable results of ease of manufacturability of the electrode. Therefore, it would

have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bolz's invention by providing helical tip electrodes to provide the predictable results of solid lead fixation, an anti-inflammatory of the claimed types to provide the predictable results of avoiding inflammation with known substances, ethylene vinyl alcohol in implantable devices to provide the predictable results of an implantable polymer with known biocompatibility, a pharmaceutical agent including an anti-proliferative drug to provide the predictable results of avoiding the formation of scar tissue around the electrode, and applying the coatings by spraying to provide the predictable results of ease of manufacturability of the electrode.

### ***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Janke et al. (US 6,501,994) is one of many teachings of insulated helical electrode structures, Lindegren (US 5,306,292) is one of many teachings of coating implanted devices with anti-inflammatories, Casas-Bejar (US 2002/0138123) is one of many teachings of providing implanted leads with the claimed anti-inflammatories and anti-proliferatives, Vachon et al. (US 5,324,324) is one of many teachings of providing coatings by spraying, and Benz et al. (US 6,879,861) is one of many teachings of providing implantable electrodes with ethylene vinyl alcohol.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL KAHRELIN whose telephone number is (571)272-8688. The examiner can normally be reached on M-F, 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George R Evanisko/  
Primary Examiner, Art Unit 3762

/Michael Kahelin/  
Examiner, Art Unit 3762